



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,975	11/14/2003	Derek Hung Kit Tam	INP0007-US	7504

7590 12/30/2005

Lawrence D. Eisen  
SHAW PITTMAN LLP  
1650 Tysons Boulevard  
McLean, VA 22102

EXAMINER

DUONG, OANH L

ART UNIT PAPER NUMBER

2155

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/706,975

Applicant(s)

TAM ET AL.

Examiner

Oanh Duong

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-12 are previously presented for examination.  
Claims 13-18 are newly added for examination.

### *Response to Amendment*

2. Applicant's arguments filed 09/30/2005 have been fully considered but they are not persuasive.

In the remarks, applicants argued in substances that

(A) Prior art does not teach MMS message.

As to point (A), examiner has given a broadest reasonable interpretation of "MMS message" as multimedia message in view of the specification of the invention (see 2 line 11). Tso teaches transcode service provider provides the capability to compress and/or scale different types of data content such as image, video (col. 3 lines 51-53). Therefore, multimedia message such as image/picture, video of Tso reads on MMS message of claimed invention.

(B) Prior art does not teach carrier, namely mobile telephone service provider.

As to point (B), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., carriers are **mobile telephone service providers**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(C) Prior art does not teach a number portability database is a repository in which mobile telephone user's numbers are matched with carriers (e.g., mobile telephone service providers).

As to point (C), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., number portability database is a repository in which **mobile telephone user's numbers are matched with carriers (e.g., mobile telephone service providers)**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(D) Prior art does not teach carrier profile or an MMS format.

As to point (D), prior art does teach carrier profile or an MMS format. For example, Tso teaches carrier/user profile (i.e., predetermined selection criterion, col. 7 line 20-col. 8 line 9) or an MMS format (i.e., content format, col. 6 line 41).

As a result, the cited prior arts do disclose method and system for providing multimedia message between source and destination as broadly claimed by the

applicants. Applicants clearly have still failed to identify specific claim limitations that would define a clearly patentable distinction over prior arts.

Applicant's arguments with respect to claims 13-18 have been considered but are moot in view of the new ground(s) of rejection.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2155

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tso et al. (Tso) 9US 6,421,733 B1).

Regarding claim 1, 6 and 12, Tso teaches a method comprising:

receiving an MMS message from a first carrier (i.e., receives information from network server 10, col. 2 lines 56-58);

querying a number portability database to determine an identity of a second carrier to which the MMS message is intended to be sent (i.e., client preference table 26, col. 7 line 15 col. 8 line 9 and col. 10 lines 16-49);

querying a carrier profile repository to access a carrier profile for the second carrier, the carrier profile including information regarding an MMS format acceptable to the second carrier (i.e., selectively transcoding data object according to a predetermined selection criteria, col. 7 lines 15-9 and col. 18 lines 12-14);

transcoding the MMS message in accordance with the carrier profile to generate a transcoded MMS message (i.e., transcodes the data stream appropriately col. 10 lines 47-49); and

sending the transcoded MMS message to the second carrier (i.e., transmits the transcoded data stream to network client, col. 10 lines 47-49).

Art Unit: 2155

Regarding claim 2, Tso teaches wherein the first carrier is an MMS message-initiating carrier (i.e., server, col. 2 lines 56-58).

Regarding claim 3, Tso teaches wherein the second carrier is an MMS message destination carrier (i.e., client, col. 3 lines 40-42).

Regarding claim 4, Tso teaches preliminarily determining whether the step of transcoding is necessary (col. 18 lines 29-35).

Regarding claims 5 and 7, Tso teaches wherein the carrier profile repository contains carrier profiles for a plurality of carriers (col. 13 lines 13-30).

Regarding claim 8, Tso teaches wherein the MMS message received from the initiating carrier is sent to the destination carrier (i.e., transcoding information transmitted between computer, such as a network server computer and a network client computer (col. 2 lines 8-12).

Regarding claim 11, Tso teaches delivering the MMS message to a legacy system belonging to the destination carrier (col. 12 lines 17-41).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso in view of Eichstaedt et al. (Eichstaedt) (US 2005/0027741 A1).

Regarding claims 9, Tso does not explicitly teach sending an SMS message to the destination carrier to alert an intended recipient of a received MMS message.

Eichstaedt teaches sending an SMS message to the destination carrier to alert an intended recipient of a received MMS message (page 3 paragraph 29).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Tso to include sending an SMS message to the destination carrier to alert an intended recipient of a received MMS message as taught by Eichstaedt because it would enable a user to register an interest and subsequently provided with a alert when new information becomes available regarding the registered interest.

Regarding claim 10, Tso does not explicitly teach sending an email to the destination carrier to alert an intended recipient of a received MMS message.

Eichstaedt teaches sending an email to the destination carrier to alert an intended recipient of a received MMS message (page 1 paragraph 13). It would have



Art Unit: 2155

been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Tso to include sending an email to the destination carrier to alert an intended recipient of a received MMS message as taught by Eichstaedt because it would enable a user to register an interest and subsequently provided with a alert when new information becomes available regarding the registered interest.

5. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso in view of Volach (US 2003/0158902 A1)

Regarding claim 13, Tso teaches the method of claim 1.

Tso does not explicitly teach the MMS message is originated from a mobile telephone

Volach teaches content delivery system wherein multimedia communications are sent to wireless devices (see abstract). Volach teaches the MMS message is originated from a mobile telephone (page 3 paragraph 32 lines 1-5)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tso to originate the MMS message by the mobile telephone as in Volach. One would be motivated to do so to allow communications to be generated from any appropriate device known in the art (Volach, page 3 paragraph 32 line 1-2).

Regarding claim 14, Tso teaches the method of claim 1.

Tso does not teach the first and second carriers are mobile telephone service provider.

Volach teaches content delivery system wherein multimedia communications are sent to wireless devices (see abstract). Volach teaches the first and second carriers are mobile telephone service provider (page 5 paragraph 70-page 6 paragraph 74).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tso to include mobile telephone service providers as in Volach. One would be motivated to do so to allow optimized delivery according to operator/provider configuration requirements (Volach, page 6 paragraph 74).

Claim 15 does not teach or define any new limitation above claim 13 and therefore is rejected for similar reason.

Claim 16 does not teach or define any new limitation above claim 14 and therefore is rejected for similar reason.

Claim 17 does not teach or define any new limitation above claim 13 and therefore is rejected for similar reason.

Claim 18 does not teach or define any new limitation above claim 13 and therefore is rejected for similar reason.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh Duong whose telephone number is (571) 272-3983. The examiner can normally be reached on Monday- Friday, 2:00PM - 10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O.D  
December 26, 2005

  
SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER